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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,018	02/05/2001	Roger N. Hastings	5236-000215	5479
7590 07/27/2005 Harness, Dickey & Pierce Suite 400 7700 Bonhomme St. Louis, MO 63105			EXAMINER RAGONESE, ANDREA M	
			ART UNIT 3743	PAPER NUMBER

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/777,018

Applicant(s)

HASTINGS ET AL.

Examiner

Andrea M. Ragonese

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 34-42 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 34-42 is/are rejected.
- 7) ☒ Claim(s) 34-42 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on May 11, 2005 has been entered.

### ***Response to Amendment***

2. The amendment filed on May 11, 2005 has been entered. Examiner acknowledges that **claims 34, 35 and 39** have been amended. Subsequently, **claims 34-42** are under consideration.

### ***Response to Arguments***

3. Applicant's arguments with respect to **claims 34-42** have been considered but are moot in view of the new ground(s) of rejection.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. **Claims 34-42** are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-3, 5-7 and 20 of U.S. Patent No. 6,911,026. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are merely reworded representations of the same subject matter.

### ***Claim Objections***

6. **Claims 34-42** are objected to because of the following informalities. Appropriate correction is required.

In **claims 34, 35 and 39**, —end— should be added after “proximal” in line 2.

In **claims 34 and 35**, “end is” should be deleted and —ends are— inserted therefor in line 9.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

9. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

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10. **Claims 34-42** are rejected under 35 U.S.C. 103(a) as being unpatentable over Ponzi (US 5,964,757) in view of Nevo (US 6,594,517 B1).

Regarding **claims 34** and **35**, Ponzi discloses a device comprising:

a catheter **12** having a proximal end and distal end and a lumen **18** therebetween;

a support structure **19/36/14** in the lumen **18** adjacent the distal end;

one or more energy/optical conduits (such as **46**, etc.) in the catheter **12**, each having a distal end supported by the support structure **19/36**; and

one or more magnet members (such as **72** with **36** and **38**) disposed in the distal end of the catheter **12** (recited throughout the specification with emphasis on column 9), as shown in Figures 2A-8.

Ponzi discloses an apparatus comprising all the limitations recited in **claims 34** and **35**, with the exception of a rotatable energy/optical conduit as well as a distal end of the catheter that is capable of being oriented by an externally applied magnetic field.

However, the use of rotatable conduits was known at the time the invention was made. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Ponzi to include rotation for the purpose of increased flexibility to the system.

In addition, the use of magnetically controlled catheters for the purpose of navigating and steering a catheter through a patient's body using magnetic members in combination with an externally applied magnetic field was known at the time the invention was made. Specifically, Nevo teaches the use of magnetically controlled catheter "in order to steer the [catheter] through the body" (see Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of use of the apparatus of Ponzi by applying an externally applied magnetic field

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to control the movement of the magnetic members of the catheter because it is well known in the art, as taught by Nevo, to use an externally applied magnetic field "in order to steer the [catheter] through the body".

Regarding **claim 36**, Ponzi as modified discloses that as applied to **claim 35**, as well as, a support structure **19/14/36** that has one or more magnet members (such as **72**, etc.) (recited in columns 9-10).

Regarding **claim 37**, Ponzi as modified discloses that as applied to **claim 36**, as well as, a support structure **19/14/36** that is a sheath, as shown in Figures 1-8.

Regarding **claim 38**, Ponzi as modified discloses that as applied to **claim 37**, as well as, a support structure that has an ablation tool **46** (column 8, lines 10-20).

Regarding **claim 42**, Ponzi discloses a device comprising:

a catheter **12** having a proximal end and distal end and a lumen **18** therebetween;

a support structure **19/36/14** in the lumen **18** adjacent the distal end;

one or more energy/optical conduits (such as **46**, etc.) in the catheter **12**, each having a distal end supported by the support structure **19/36**; and

one or more magnet members (such as **72** with **36** and **38**) disposed in the distal end of the catheter **12** (recited throughout the specification with emphasis on column 9), as shown in Figures 2A-8.

Ponzi discloses an apparatus comprising all the limitations recited in **claim 42**, with the exception of one or more magnetic members that are positioned in the wall of the catheter or are rotatable within the catheter as well as a distal end of the catheter that is capable of being oriented by an externally applied magnetic field.

However, the magnet members of Ponzi are positioned in the wall of the tip, which can be considered an equivalent. Also, the use of rotatable magnets was known at the time the invention was made. Therefore, it would be obvious to one with ordinary skill in the art to modify the invention of Ponzi to include rotation for the purpose of increased steering of the system.

In addition, the use of magnetically controlled catheters for the purpose of navigating and steering a catheter through a patient's body using magnetic members in combination with an externally applied magnetic field was known at the time the invention was made. Specifically, Nevo teaches the use of magnetically controlled catheter "in order to steer the [catheter] through the body" (see Abstract). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the method of use of the apparatus of Ponzi by applying an externally applied magnetic field to control the movement of the magnetic members of the catheter because it is well known in the art, as taught by Nevo, to use an externally applied magnetic field "in order to steer the [catheter] through the body".

Regarding **claim 40**, Ponzi as modified discloses that as applied to **claim 39**, as well as, an ablation member **46** at the catheter distal end, as shown in Figures 1-8.

Regarding **claim 41**, Ponzi as modified discloses that as applied to **claim 40**. However, Ponzi does not recite one or more magnet members that are comprised by the support member. The electrode tip of Ponzi has the ablation laser and is considered an equivalent given the disclosure in the current specification.

Regarding **claim 42**, Ponzi as modified discloses that as applied to **claim 41**, as well as, a support structure that has a passage **78** for a guidewire (column 11, lines 65-67).




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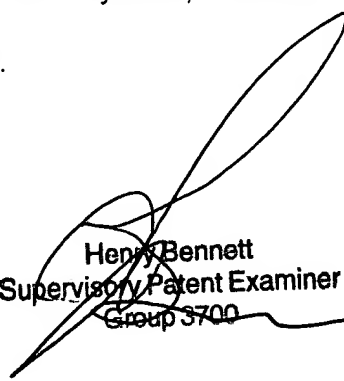
**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Andrea M. Ragonese whose telephone number is 571-272-4804**. The examiner can normally be reached on Monday through Friday from 9:00 am until 5:00 pm.

12. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry A. Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

13. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AMR   
July 25, 2005

  
Henry A. Bennett  
Supervisory Patent Examiner  
Group 3700